

REMARKS

The present application was filed on July 25, 2000 with claims 1-25. Claims 1, 24 and 25 are independent claims. In the final Office Action, the Examiner: (i) rejected claims 1-4, 24 and 25 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,128,633 to Michelman et al. (hereinafter "Michelman") in view of U.S. Patent No. 5,838,819 to Ruedisueli et al. (hereinafter "Ruedisueli"); (ii) rejected claim 11 under 35 U.S.C. §103(a) as being unpatentable over Michelman in view of Ruedisueli and further in view of U.S. Patent No. 6,502,114 to Forcier (hereinafter "Forcier") and U.S. Patent No. 5,911,146 to Johari et al. (hereinafter "Johari"); (iii) rejected claim 19 under 35 U.S.C. 103(a) as being unpatentable over Michelman in view of Ruedisueli and in further view of U.S. Patent No. 5,805,118 to Mishra et al. (hereinafter "Mishra"); (iv) rejected claim 23 under 35 U.S.C. 103(a) as being unpatentable over Michelman in view of Ruedisueli, Forcier and Johari and in further view of U.S. Patent No. 5,909,221 to Nakai et al. (hereinafter "Nakai"); and (v) indicated allowable subject matter in claims 5-10, 12-18 and 20-22.

Applicants appreciate the acknowledgment of allowable subject matter in claims 5-10, 12-18 and 20-22. However, in this response, Applicants: (i) again traverse the various §103(a) rejections of claims 1-4, 11, 19 and 23-25 for at least the following reasons; and (ii) file a Notice of Appeal concurrently herewith.

Regarding the §103(a) rejection of independent claims 1, 24 and 25, Applicants again respectfully assert, as first set out in their previous response dated January 12, 2004, that the Michelman/Ruedisueli combination fails to establish a proper case of obviousness under 35 U.S.C. §103(a), as specified in M.P.E.P. §2143.

To reiterate, as set forth in M.P.E.P. §2143, three requirements must be met to establish a proper case of obviousness. First, there must be some suggestion or motivation to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited combination must teach or suggest all the claim limitations. While it is sufficient to show that a proper case of obviousness has not been established by showing that one of the requirements has not been met, Applicants respectfully believe that none of the requirements have been met.

First, there is a clear lack of motivation to combine the references. For at least this reason, a proper case of obviousness has not been established. Michelman is directed to a method of

manipulating page breaks in documents created in accordance with standard word processing and spreadsheet applications such as Microsoft Word and Excel (see columns 1 and 2 of Michelman), while Ruedisueli is directed to a method of processing electronic copies of handwritten notes. That is, the teachings in each reference are directed to completely different environments; one (Michelman) toward standard word processing and spreadsheet applications, the other (Ruedisueli) toward a handwritten note processing environment. Thus, while Ruedisueli is related to a handwriting system, Michelman has nothing to do with a handwriting system. However, other than a very general and conclusory statement in the Office Action, there is nothing in the two references that reasonably suggests why one would actually combine the teachings of these two references.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344.

In the final Office Action at page 3, the Examiner provides the following restatement (i.e., changed from the previous non-final Office Action) to prove motivation to combine Michelman and Ruedisueli, with emphasis supplied: “[i]t would have been obvious to one of ordinary skill at the time of the invention to apply Ruedisueli to Michelman, providing Michelman the benefit of adding [an] electronic notepad as taught by Ruedisueli . . . to the automatic page break pagination”

Despite the elaboration added by the Examiner in the final Office Action, Applicants submit that this statement is still based on the type of “subjective belief and unknown authority” that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, other than citing disparate portions of each of the references, the Examiner fails to identify any objective evidence of record which supports the proposed combination. That is, there is no objective support given for why one would be motivated to modify techniques (Michelman) that have nothing to do with a handwriting system to include techniques associated with a handwriting system (Ruedisueli).

Second, Applicants reassert that there is no reasonable expectation of success in achieving the present invention through a combination of Michelman and Ruedisueli. For at least this reason, a proper case of obviousness has not been established. Despite the assertion in the final Office Action, Applicants do not believe that Michelman and Ruedisueli are combinable since it is not clear how one would combine them. That is, how would one implement techniques relating to a handwriting system in a system that does not process handwriting. There was no guidance provided in the previous Office Action, and there is no guidance given in the final Office Action. However, even if combined, for the sake of argument, they would not achieve the techniques of the claimed invention.

Third, Applicants reassert that even if combined, the Michelman/ Ruedisueli combination fails to teach or suggest all of the limitations of the claims. For at least this reason, a proper case of obviousness has not been established.

For example, as asserted in Applicants' previous response dated January 12, 2004, the Michelman/Ruedisueli combination fails to teach or suggest "automatically identifying, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page," as in the claimed invention.

For example, as the present specification explains, at page 1, line 15, through page 2, line 2:

[In accordance with existing techniques,] . . . to maintain . . . accurate correspondence between the physical page and the electronic copy, the writer is required to "turn" the electronic page when changing to a new or previous paper page by pressing the corresponding page-forward or page-backward button on the PDN [personal digital notepad]. These buttons effect synchrony between the physical and electronic page by recording these events in the data stream. Asynchrony between the paper and electronic pages occurs when a writer forgets to press the appropriate button on the device or accidentally presses the button too many times. Subsequent writing is then electronically recorded on the wrong electronic page, and the new electronic ink is recorded on top of the page's original electronic ink. This problem may be compounded since the user may flip forward or backward by several pages at a time and may do so several times within a single document.

Later, when the resultant electronic page is viewed, the merged original and overwritten electronic ink can be confusing and may be difficult to read and correct.

To address this problem, the claimed invention automatically identifies, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page.

A key aspect with respect to the claimed invention is that the potential page breaks are automatically identified. So, even if a writer forgets to press the appropriate button on the device or accidentally presses the button too many times, causing asynchrony between the paper and electronic pages, the claimed invention automatically identifies, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page.

Michelman has nothing to do with handwriting systems and, therefore, does not address the unique electronic/physical page asynchrony problem associated with handwriting systems. However, while Ruedisueli relates to handwriting systems, it does not address the problem that the claimed invention addresses. That is, while Ruedisueli explains that page identifiers (36) are manually entered in the upper right hand corner of a page to set the page number (column 4, lines 46-56 of Ruedisueli) and to change the page number (column 5, lines 26-40 of Ruedisueli), there is no teaching of automatically identifying, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page, as in the claimed invention.

Thus, while Ruedisueli illustrates a user signaling a page change, the problem is that this manual signaling could be wrong, or the user could just forget to manually signal a page change, resulting in the above-described asynchrony problem. Ruedisueli provides no solutions for this

problem. Also, while Michelman mentions allowing a user to select a page break via a graphical user interface and then adjusting the page breaks for the remainder of a document, again, the initial selection is still a manual process, not an automated process.

It appears that the final Office Action still fails to address this claim limitation.

For at least these reasons, it is asserted that independent claims 1, 24 and 25 are patentable over Michelman and Ruedisueli.

Regarding the §103(a) rejection of the various dependent claims, Applicants respectfully assert that the various combinations, based on Michelman/Ruedisueli that also include one or more of Forcier, Johari, Nakai and Mishra, also fail to establish proper cases of obviousness under 35 U.S.C. §103(a), as specified in M.P.E.P. §2143. Such dependent claims are patentable over the cited combinations not only due to their dependence on the above-mentioned independent claims but also because such claims recite patentable subject matter in their own right.

In view of the above, Applicants believe that claims 1-25 are in condition for allowance, and respectfully request withdrawal of the §103(a) rejections.

Respectfully submitted,



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